



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,517	11/08/2001	Yasuhiro Doi	CU-2711 RJS	5426
26530	7590	03/03/2005	EXAMINER	
LADAS & PARRY LLP 224 SOUTH MICHIGAN AVENUE SUITE 1200 CHICAGO, IL 60604			WONG, EDNA	
			ART UNIT	PAPER NUMBER
			1753	

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

4

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/008,517	Applicant(s) DOI ET AL.	
	Examiner Edna Wong	Art Unit 1753	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See pages 2-5. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 8-11.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

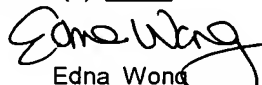
8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See pages 2-5.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.


 Edna Wong
 Primary Examiner
 Art Unit: 1753

ADVISORY ACTION

This is in response to the Amendment dated February 4, 2005. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Claim Rejections - 35 USC § 102

- I. Claim **8** has been rejected under 35 U.S.C. 102(b) as being anticipated by **Maenza et al.** (US Patent No. 5,494,782).

The rejection of claim 8 under 35 U.S.C. 102(b) as being anticipated by Maenza et al. is as applied in the Office Action dated October 4, 2004 and incorporated herein. The rejection has been maintained for the reasons discussed below.

- II. Claim **8** has been rejected under 35 U.S.C. 102(e) as being anticipated by **Yang et al.** (US Patent No. 6,409,902 B1).

The rejection of claim 8 under 35 U.S.C. 102(e) as being anticipated by Yang et al. is as applied in the Office Action dated October 4, 2004 and incorporated herein. The rejection has been maintained for the reasons discussed below.

Claim Rejections - 35 USC § 103

- I. Claim **9** has been rejected under 35 U.S.C. 103(a) as being unpatentable over

Yang et al. (US Patent No. 6,409,902 B1) as applied to claim 8 above, and further in view of **Krinke** (US Patent No. 5,997,709).

The rejection of claim 9 under 35 U.S.C. 103(a) as being unpatentable over Yang et al. as applied to claim 8 above, and further in view of Krinke is as applied in the Office Action dated October 4, 2004 and incorporated herein. The rejection has been maintained for the reasons discussed below.

II. Claim **10 and 11** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **Krinke** (US Patent No. 5,997,709) in view of **Ueda et al.** (US Patent No. 4,537,732).

The rejection of claims 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over Krinke in view of Ueda et al. is as applied in the Office Action dated October 4, 2004 and incorporated herein. The rejection has been maintained for the reasons discussed below.

Applicants state that the present amendment has amended the claims to replace the open transition phrase "comprising" with the closed transition phrase "consisting", thereby precluding the inclusion of additional steps.

In response, the present amendment to the claims raises new issues that would require further consideration and search.

Although the preamble of claim 8 is closed to additional steps, the body of claim

8 is open to additional steps because the steps of:

(a) "by a deposition film forming process" (from claim 8, lines 3-4) includes deposition film forming process steps. These steps include the deposition film forming process steps of **10 to 50** as shown in Fig. 1 of Maenza (col. 1, line 13 to col. 2, line 6); and

(b) "by an electroforming process" (from claim 8, lines 5-8) includes electroforming process steps. These steps include the electroforming process steps of **60-90** as shown in Fig. 1 of Maenza (col. 2, lines 7-35).

The preamble of claim 10 uses two transition phrases to present the method steps. They are "includes" (from claim 10, line 2) and "consisting" (from claim 10, line 7).

The word "includes" opens the claim to additional steps and the word "consisting" closes the claim to additional steps. This is contradictory as to the scope of the claim.

Furthermore, the plating, molding and performing steps (from claim 10, lines 9-12) are further limiting elements in the reproduction process recited in the preamble rather than the method of reproducing a master die.

Claim Objections

Claim 11 is objected to because of the following informalities:

Claim 11

line 1, "A property check method of a die according to claim 10" is improper.

Claim 10 is a method of reproducing a master die.

Appropriate correction is required.

Citations

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

JP 7-241856 is cited to teach a method of electroforming a stamper.

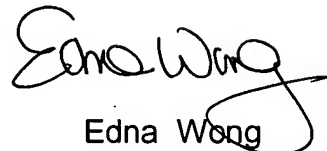
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 3:30 pm, Flex Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 1753

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Edna Wong". The signature is fluid and cursive, with a large loop at the end of the last name.

Edna Wong
Primary Examiner
Art Unit 1753

EW
March 1, 2005